

REMARKS/ARGUMENTS

The Office Action dated November 6, 2006 has been carefully considered. Claims 2-12, 16-18, and 20-25 are pending in the present application with claims 2, 20 and 23 being in independent form. By the present Amendment, claims 2, 20 and 23 have been amended in order to further clarify the features of the present application.

The Examiner has objected to claims 2, 20 and 23 based on informalities. Specifically, with regard to each of these claims, the Examiner argues that the word “shaped” should be inserted into the claims such that they will read, “wherein the tool and cutter tip are both shaped to be operable for metal cutting.” The amendments to claims 2, 20 and 23 are believed to correct this minor formal error.

Accordingly, it is respectfully requested that the objection to claims 2, 20 and 23 be reconsidered and withdrawn.

Claims 2, 3 and 20-25 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 4,971,483 to Kress et al. (hereinafter “Kress ‘483”) in view of U.S. Patent No. 5,915,889, also to Kress et al. (hereinafter “Kress ‘889”). Reconsideration of this rejection is respectfully requested.

The Examiner argues that Kress ‘483 substantially discloses all of the features of claim 2 of the present application, for example. The Examiner concedes that Kress ‘483 does not disclose a cutter tip having at least one V-shaped cross section clamping notch formed on the front/top side. The Examiner contends however, that Kress ‘889 discloses this feature. The Examiner concludes that it would have been obvious to combine the teaching of Kress ‘889 to include this feature in the device of Kress’483. Applicants respectfully disagrees.

Kress ‘483 relates to a specialized tool utilized for making holes. While Kress ‘483 may disclose a cutter plate that is a symmetrical polygon, the cutter plate of Kress et al. has a main cutter HS and an auxiliary cutter NS as is shown in Fig. 3 thereof. The main cutter HS has a rounded shape while the auxiliary cutter NS has a more straight edge. Kress ‘483, however, fails to disclose a tool including “a cutter tip having at least one geometrically defined cutting edge, the cutting edge formed in a straight line between two adjacent corners of the cutter tip,” and “two

supporting regions in the tool for supporting the cutter tip, ... the supporting regions also being so oriented that a line bisecting the angle between the support surfaces runs essentially perpendicular to an active one of the cutting edges,” as is required by amended claim 2 of the present application, for example.

As is noted above, the main cutter HS of Kress ‘483 is substantially round in shape and thus is not formed in a straight line as is required by claim 1 of the present application. Further, there does not appear to be any disclosure in Kress ‘483 to suggest that the supporting recess 31 is positioned such that a line bisecting an angle between the surfaces thereof is perpendicular to the rounded cutting surface. The Examiner merely points to Fig. 6 as allegedly disclosing this feature, however, there is no disclosure in Kress ‘483 to support this feature. In addition, it is clear that the only straight line cutting surface NS in Kress’843 is not perpendicular to the line bisecting the angle between the surfaces of the recess 31.

Even if Kress ‘483 did disclose the features of claim 2 discussed above, which it does not, the Examiner has conceded that it does not disclose at least one V-shaped cross-section clamping notch formed on the front side as is further required by claim 2. The Examiner relies on Kress ‘889 as allegedly disclosing this feature, however, the Examiner has failed to identify any suggestion or motivation to modify the tool of Kress ‘483 in light of Kress ‘889. As is well known, “[O]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so.” See M.P.E.P. §2143.01 I quoting *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). The Examiner has not done so in this application. The Examiner points to a portion of Kress ‘889 that generally discusses secure clamping, but makes no mention whatsoever of any advantage to be obtained by a V-shaped cross section. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” See M.P.E.P. §2143.01 III quoting *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner has failed to identify any such benefit to be found by the combination that he suggested. Indeed, as was noted above, Kress ‘483 is directed to a specific tool for use in making holes. Thus, there appears to be little benefit to modifying such a specialized tool at the risk of altering its usefulness.

Accordingly, it is respectfully submitted that claim 2 and the claims depending therefrom are patentable over the cited art for at least the reasons described above.

Similarly, claim 20 relates to a method for metal cutting machining of a surface in an opening comprising operating a tool to metal cut machine a surface in an opening where the tool includes “a cutter tip having at least one geometrically defined cutting edge, the cutting edge formed as a straight line between two adjacent corners of the cutter tip,” and “two supporting regions ... the supporting regions also being so oriented that a line bisecting the angle between the support surfaces runs essentially perpendicular to an active one of the cutting edges.” Thus, it is believed that claim 20, and the claims depending therefrom are also patentable over the cited art for reasons at least similar to those described above with reference to claim 2.

Independent claim 23, and the claims depending therefrom, are believed to be patentable over the cited art for at least similar reasons as well.

Claims 4, 5 and 7 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kress ‘483 in view of Kress ‘889 and further in view of previously cited Breuning ‘482. Reconsideration of this rejection is respectfully requested.

Claims 4-5 and 7 depend from claim 2, either directly or indirectly. As noted above, claim 2 is believed to be patentable over the cited art for at least the reasons described above. Further, it is respectfully submitted that claim 2 is patentable over the combination of Kress ‘483 , Kress ‘889 and Breuning since none of these references, either alone or in combination, show or suggest the patentable features of claim 2 described above.

Accordingly, it is respectfully submitted that claims 4, 5 and 7 are patentable over the cited art for at least the reasons described above.

Claim 6 has been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kress ‘483 in view of Kress ‘889 and further in view of Breuning ‘842 and Erickson ‘650. Reconsideration of this rejection is respectfully requested.

Claim 6 depends indirectly from claim 2. As noted above, claim 2 is believed to be patentable over the cited art for at least the reasons described above. Further, it is respectfully submitted that claim 2 is patentable over the combination of Kress ‘483 , Kress ‘889 and Breuning

‘842 and Erickson ‘650 since none of these references, either alone or in combination, show or suggest the patentable features of claim 2 described above.

Claim 8 has also been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kress ‘483 in view of Kress ‘889 and further in view of Breuning ‘842 and previously cited Satran ‘724. Reconsideration of this rejection is respectfully requested.

Claim 8 depends indirectly from independent claim 2. As noted above, claim 2 is believed to be patentable over the cited art for at least the reasons described above. Further, it is respectfully submitted that claim 2 is patentable over the combination of Kress ‘483 , Kress ‘889, Breuning ‘842 and Satran ‘724 since none of these references, either alone or in combination, show or suggest the patentable features of claim 2 described above.

Accordingly, it is respectfully submitted that claim 8 is patentable over the cited art for at least the reasons described above.

Claim 9 has also been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kress ‘483 in view of Kress ‘889 and further in view of Breuning ‘842. Reconsideration of this rejection is respectfully requested.

Claim 9 depends from independent claim 2. As noted above, claim 2 is believed to be patentable over the cited art for at least the reasons described above. Further, it is respectfully submitted that claim 2 is patentable over the combination of Kress ‘483, Kress ‘889 and Breuning ‘842 since none of these references, either alone or in combination, show or suggest the patentable features of claim 2 described above.

Accordingly, it is respectfully submitted that claim 9 is patentable over the cited art for at least the reasons described above.

Claims 10-12 have also been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kress ‘483 and Kress ‘889 further in view of Royal ‘198. Reconsideration of this rejection is respectfully requested.

Claims 10-12 depend from independent claim 2. As noted above, claim 2 is believed to be patentable over the cited art for at least the reasons described above. Further, it is respectfully submitted that claim 2 is patentable over the combination of Kress ‘483, Kress ‘889 and Royal

'198 since none of these references, either alone or in combination, show or suggest the patentable features of claim 2 described above.

Accordingly, it is respectfully submitted that claims 10-12 are patentable over the cited art for at least the reasons described above.

Claims 16-17 have also been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kress '483, Kress '889 and further in view of Link '155. Reconsideration of this rejection is respectfully requested.

Claims 16-17 depends from independent claim 2. As noted above, claim 2 is believed to be patentable over the cited art for at least the reasons described above. Further, it is respectfully submitted that claim 2 is patentable over the combination of Kress '483 , Kress '889 and Link '155 since none of these references, either alone or in combination, show or suggest the patentable features of claim 2 described above.

Accordingly, it is respectfully submitted that claims 16-17 are patentable over the cited art for at least the reasons described above.

Claim 18 has also been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kress '483 in view of Kress '889 and further in view of Hellstrom '081. Reconsideration of this rejection is respectfully requested.

Claim 18 depends from independent claim 2. As noted above, claim 2 is believed to be patentable over the cited art for at least the reasons described above. Further, it is respectfully submitted that claim 2 is patentable over the combination of Kress '483 , Kress '889 and Hellstrom '081 since none of these references, either alone or in combination, show or suggest the patentable features of claim 2 described above.

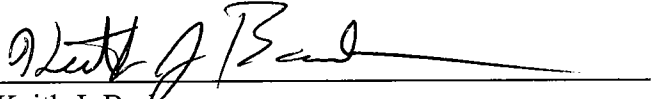
Accordingly, it is respectfully submitted that claim 18 is patentable over the cited art for at least the reasons described above.

In light of the remarks and amendments made herein, it is respectfully submitted that claims 2-12, 16-18 and 20-25 of the present application are patentable over the cited art and are in condition for allowance.

Reconsideration of the present application is respectfully requested.

THIS CORRESPONDENCE IS BEING
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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Keith J. Bankaus", written over a horizontal line.

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